

Appl. No. 10/054,131
Amendment transmitted on August 15, 2005
Reply to Office action of April 15, 2005

REMARKS

Claims 1-2 are pending in the present application. By the present Amendment, the subject matter of claim 3 has been incorporated into claim 1, and claim 3 canceled.

The Present Invention

The present application relates to a press installation constructed to regulate the temperature of the press, and specifically the temperature of the press platens contained inside the press. (Paragraph 0015). The temperature of these platens (which compress the wood-additive mixtures into pressed boards or other composite products) is regulated by controlling the temperature of the oil supplied to the press platens. By changing the blend of cooler and warmer oil that is supplied to the press, the temperature of the platens can be regulated to within a relatively fine degree of tolerance. (Id.)

Rejection under 35 U.S.C. §102

The Examiner has rejected claims 1-3 under 35 U.S.C. §102 as being anticipated by Fails et al., U.S. Patent No. 3,785,279 ("Fails"). The Examiner asserts that Fails discloses an apparatus for the production of wood boards, which includes a plurality of platens, means for regulating the temperature of the platens, means for circulating a heating fluid like superheated steam through the platens, as well as means for detecting the temperature of the heating fluid. (See Office Action of April 15, 2004 pages 2-3). Applicants disagree with the Examiner's analysis for the reasons that follow.

For a claim to be rejected as anticipated under 35 U.S.C. §102, it must be shown that the prior art reference teaches or suggests all of the claimed elements and limitations. (M.P.E.P. §706.02).

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Fails does not teach or suggest all of the elements of the present claims, because Fails fails to specify the use of any of the heating fluids set forth in claim 1 as presently amended. Present claim 1 recites that the heating fluid used in the present invention is selected from heating fluids including natural gas, superheated steam, and heated oil. Fails fails to mention any of those heating fluids, disclosing only steam and no other heating fluids. Applicants maintain that superheated steam and steam are two entirely different kinds of heating fluids, and thus the use of steam in Fails does not anticipate the use of superheated steam as recited in the present claims.

Rejection Under 35 U.S.C. §103

The Examiner has rejected claims 1-3 under 35 U.S.C. §103 as being unpatentable over the combination of Fails and Wollny, U.S. Patent No. 6,668,714 ("Wollny"). The Examiner applies Wollny in the event that Applicants dispute that Fails inherently discloses a heat exchanger. Specifically, the Examiner maintains that Wollny shows a heat exchanger utilized within a multi-platen press in order to continuously adjust the temperature of the press platens. (Office Action of April 15, 2005, page 3). Applicants respectfully disagree with the Examiner's analysis for the reasons that follow.

Wollny discloses a multi-platen press having various flow-passages systems to communicate a heat-exchanging liquid, controlled by valves, and used to heat or even cool the adjacent platens. (Col. 2, lines 5-55).

The teachings of Fails are summarized above.

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In order to establish a prima facie case of obviousness, the Examiner must make all of the following showings: (1) there must be some suggestion or motivation to modify or combine the reference(s) as suggested by the Examiner (it is not sufficient to say that the cited reference(s) can be modified or combined without a teaching in the prior art to suggest the desirability of the combination or modification); (2) there must also be a reasonable expectation of success for the modification or combination; and (3) the reference(s), taken either alone or in combination, must teach or suggest all elements of the present claims. (M.P.E.P. §2143).

Applicants maintain that the present claims are not obvious in view of the combination of Wollny and Fails for the reasons that follow. First, the Examiner has not identified any suggestion or motivation that would have motivated a person of ordinary skill in the art to combine the references as suggested by the Examiner. The Examiner suggests that it would have been obvious to combine these references in order to, "provide Fails with a heat exchanger, as taught by Wollny, in order to main the platens temperature continuously." (Office Action of April 15, 2005, Page 3). However, the Examiner does not identify anywhere in Fails, where Fails speaks of the desirability or need to main the platen temperature continuously. Instead this motivation for using the heat-exchanger as taught by Wollny in the Fails device seems to be the rationale of the Examiner, alone, upon looking at these references in hindsight. Such hindsight reconstruction is, of course, impermissible.

Nor has the Examiner made any showing that a person of ordinary skill would have a reasonable expectation of success for combining these references in the manner suggested by the Examiner. While Fails and Wollny both relate to presses for manufacturing

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composite wood products, the devices disclosed in each reference are far from identical. Thus, before the Examiner can assert that a person of ordinary skill in the art would have had a reasonable expectation of combining these references in the manner suggested by the Examiner, it is necessary for the Examiner to explain how these two references would be combined, and how that process of combining the two references would, to a person of ordinary skill in the art, have a reasonable expectation of being successful. The Examiner has not provided any explanation for how that is so.

Finally, the combination of Wollny and Fails references applied by the Examiner fails to disclose all of the elements of the present claims.

Therefore, based on the above remarks, the Examiner has failed to establish that claims 1-2 are obvious in view of Wollny and Fails. Reconsideration and withdrawal of the rejections of claims 1-2 are respectfully requested.

CONCLUSION

Reconsideration and withdrawal of the objection and rejection of the claims in view of the remarks provided herein and allowance of the claims being prosecuted are respectfully requested.

Respectfully submitted,

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